

REMARKS

Election

Applicant hereby provisionally elects **Group II** (claims 6-9), drawn to methods for increasing the size of a bone growth plate in an abnormal bone comprising administering a substance activating guanylyl cyclase B (GC-B) **with traverse**. Applicant reserves the right to file divisional application(s) directed to non-elected subject matter.

Restriction Requirement

The Restriction Requirement required restriction to one of four Groups I-IV, provided *infra*, which are purportedly distinct inventions under 35 U.S.C. § 121. The Restriction Requirement requires Applicant elects one of the following four (4) allegedly distinct inventions:

- Group I: Claims 1-5, drawn to a therapeutic agent (i.e., a composition);
- Group II: Claims 6-9, drawn to a method to increase the size of a bone growth plate in an abnormal bone;
- Group III: Claims 10-13, drawn to a method to elongate a bone; and
- Group IV: Claims 14-17, drawn to a method to rescue cartilage growth inhibition.

Applicant respectfully traverses and requests reconsideration of the restriction requirement in view of the following remarks.

Applicant respectfully submits that the Restriction Requirement is improper, as it does not establish that searching for all designated inventions would constitute an undue burden on the USPTO. Accordingly, Applicant submits that the Restriction Requirement is improper and should be withdrawn.

According to the MPEP, when claims can be examined together without undue burden, the USPTO must examine the claims on the merits even though they are directed to independent and distinct inventions. *See* MPEP § 803. In establishing that an “undue burden” would exist for co-examination of claims, the USPTO must show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. To show undue burden resulting from searching difficulties, the USPTO must show that the restricted groups have a separate classification, acquired a separate status in the art, or that searching would require different fields of search. *See* MPEP § 808.02. Therefore, restriction between inventions is only proper when a search burden exists for the Examiner to search all the

inventions claimed. If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. *See* MPEP § 803.01.

Applicant also submits that it would not constitute an undue burden to examine the inventions of Groups I, II, III, and IV together because the search for a composition comprising and a method of using a substance activating guanylyl cyclase B (GC-B) would all necessarily be conducted in the same field of search because they all pertain to a substance activating guanylyl cyclase B (GC-B). Therefore a search of any one of these Groups would likely overlap with the other Groups and it would not constitute an undue burden to search Groups I, II, III, and IV. Moreover, it would not constitute an undue burden to examine the inventions of Groups II and III together because the search for a methods for increasing the size of a bone growth plate in an abnormal bone would necessarily be conducted in the same field of search as the elongation of an abnormal bone as the both pertain to treatments of abnormal bone comprising the use of a substance activating guanylyl cyclase B (GC-B). Applicants further note that a publication describing a composition typically also describes methods for using that same composition and *vice versa*, and therefore it is likely that a search of one will encompass the other.

In light of the above, Applicant respectfully requests that the restriction requirement be reconsidered and withdrawn and that all claims be prosecuted in the same patent application. In the event the requirement is made final, and in order to comply with 37 C.F.R. § 1.143, Applicant reaffirms the election **with traverse** of Group II (claims 6-9), holding claims 1-5 and 10-17 in abeyance under the provisions of 37 C.F.R. § 1.142(b) until final disposition of the elected claims.

CONCLUSION

Applicant maintains that the restriction requirement is improper and that all pending claims, *i.e.*, claims 1-17, should be examined. If the Examiner believes that prosecution might be advanced by discussing the application with Applicants' representatives, in person or over the telephone, Applicant welcomes the opportunity to do so.

Respectfully submitted,

HUNTON & WILLIAMS LLP

Dated: March 15, 2007

By: 

Robert M. Schulman
Registration No. 31,196

Christopher J. Nichols, Ph.D.
Registration No. 55,984

HUNTON & WILLIAMS LLP
Intellectual Property Department
1900 K Street, N.W., Suite 1200
Washington, DC 20006-1109
(202) 955-1500 (telephone)
(202) 778-2201 (facsimile)

RMS/CJN:cdh